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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/412,969

10/05/1999

JENNIE CHING

BC9-99-024

1335

23334

7590

02/02/2004

FLEIT, KAIN, GIBBONS, GUTMAN, BONGINI
& BIANCO P.L.

ONE BOCA COMMERCE CENTER
551 NORTHWEST 77TH STREET, SUITE 111
BOCA RATON, FL 33487

EXAMINER

CHUNG, JASON J

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 02/02/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/412,969

Applicant(s)

CHING ET AL.

Examiner

Jason J. Chung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12/2/03 have been fully considered but they are not persuasive.

The applicant argues on page 11 of the response that Picco does not disclose "a time when the multimedia segment is rendered", "wherein the playlist contains pointers to indicate where each of the multimedia segments selected from a group of media sources consisting of broadcast stream, internet, and removable computer readable medium is located", and "the playlist is based on user demographics assembled by the program provider". The examiner respectfully disagrees with these assertions.

Regarding the limitation for a time when the multimedia segment is rendered, Picco discloses the data transmission facility assembles and transmits individualized instructions (playlist) to each set-top box and the instructions indicate what local content should be stored and when each piece of local content should be inserted into the live data streams (column 3, lines 1-13), which meets the limitation on receiving a playlist and program content from a program provider wherein the playlist is a list of instructions for rendering of one or more multimedia segments into a multimedia presentation. The applicant states on page 12, lines 4-7 that the individualized instructions do have a time element, however, not for adding the audio overlay. The examiner has provided an additional reference for the teaching of a commercial with an audio overlay.

Regarding the limitation of the playlist with pointers selecting from a group of media sources **consisting of** is a Markush claim, which means the limitation for **at least** one of the

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sources must be met. See MPEP 2173.05(h). Picco discloses the digital data streams are broadcasted to users (column 3, lines 1-13 and column 4, lines 51-65), which meets the limitation on broadcast stream. Additionally, Picco discloses the system could use a network such as the Internet to broadcast the targeted commercial (column 14, lines 58-67); a network has a server computer (program provider) that will have the database memory (computer readable medium) of local content to provide to the user.

Regarding the limitation on the demographics assembled by the program provider, the applicant discloses, "A programming distributor will generally obtain information from, or about, its customers that is of great use to program providers and advertiser" on page 7, lines 23-25 of the specification. The applicant further discloses the cable headend, which is a provider can thus provide the business model for tailoring and delivering multimedia segments in a network as stated on page 7, line 25-page 8, line 15 of the specification. Thus, the demographics information is gathered from, or about the customers and provided to the cable headend. Picco discloses the uplink facility 102 (figure 4, column 6, lines 42-56). Picco discloses the uplink facility multiplexes local content (segments) with the live digital stream and viewer information is feedback to the uplink facility to provide data about households (column 6, line 57-column 7, line 32). Picco discloses a scheduler transmits control information instructing the settop box and each piece of local content has a content profile associated with it which determines which users may be downloaded (column 7, lines 33-61). Picco discloses the content profile indicating only the houses in a geographic region having a specific zip code should store particular content (column 7, line 61-column 8, line 6), which meets the limitation on the playlist is based on demographics assembled by the program provider.

Applicant's arguments with respect to the audio overlay limitation have been considered but are moot in view of the new ground(s) of rejection.

The limitation for, "wherein the playlist contains an entry indicating if the multimedia segment is rendered as video with a customized audio overlay" can be found in page 16, lines 5-12 of the specification. The specification states that the video mail merge for advertising can be used such as an audio track unique to the specific household can be played out with the ad. The examiner interprets the customized audio overlay to be an audio track with the video message.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9, 11-26, 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Picco (US Patent # 6,029,045) in view of Lindstrom (US Patent # 5,029,014).

Regarding claim 1, Picco discloses the data transmission facility assembles and transmits individualized instructions (play-list) to each set-top box and the instructions indicate what local content should be stored and when each piece of local content should be inserted into the live data streams (column 3, lines 1-13), which meets the limitation on receiving a playlist and program content from a program provider wherein the playlist is a list of instructions for rendering of one or more multimedia segments into a multimedia presentation and wherein the playlist contains a time when the multimedia segment is to be rendered. Picco discloses the

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broadcaster can deliver geographically localized content (column 2, lines 49-58). Picco discloses the broadcaster segments its viewers so advertisers may target their commercials at a particular portion of the broadcaster's audience (column 2, lines 59-67).

Picco discloses the uplink facility 102 (figure 4, column 6, lines 42-56). Picco discloses the uplink facility multiplexes local content (segments) with the live digital stream and viewer information is feedback to the uplink facility to provide data about households (column 6, line 57-column 7, line 32). Picco discloses a scheduler transmits control information instructing the settop box and each piece of local content has a content profile associated with it which determines which users may be downloaded (column 7, lines 33-61). Picco discloses the content profile indicating only the houses in a geographic region having a specific zip code should store particular content (column 7, line 61-column 8, line 6), which meets the limitation on the playlist is based on demographics assembled by the program provider. Picco discloses a private data feed may provide local content to the set top box (column 8, lines 23-55).

Regarding the limitation of the playlist with pointers selecting from a group of media sources **consisting of** is a Markush claim, which means the limitation for **at least** one of the sources must be met. See MPEP 2173.05(h). Picco discloses the digital data streams are broadcasted to users (column 3, lines 1-13 and column 4, lines 51-65), which meets the limitation on broadcast stream. Additionally, Picco discloses the system could use a network such as the Internet to broadcast the targeted commercial (column 14, lines 58-67); a network has a server computer (program provider) that will have the database memory (computer readable medium) of local content to provide to the user.

Picco discloses the individualized instructions (playlist) transmitted from the data transmission facility indicate which piece of local content (multimedia segments required) should be stored and inserted into the live data stream (column 3, lines 1-13), which meets the limitation for receiving from the program provider the multimedia segments required by the playlist.

Picco discloses the local content (segment) is output to a television to be viewed by a viewer (column 12, lines 24-36), which meets the limitation on receiving multimedia presentation on the display by rendering the segments directed by the playlist.

Picco fails to disclose the playlist contains an entry indicating if the multimedia segment is rendered as video with a customized audio overlay. Lindstrom discloses the control means 1 in response to a programmed schedule (playlist) selects a series of spot messages from the spot messages stored in the storage means and the control means switches sources to insert the spot message (column 3, line 64-column 4, line 23). Lindstrom discloses the programmed schedule can cause the control means can add audio signals drawn to a particular local advertiser to produce a custom spot message thereby producing a full motion video with audio (column 4, line 44-column 5, line 16). Lindstrom discloses there is a need to produce inexpensive and effective full motion video commercials (column 2, lines 4-22). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Picco to have a playlist containing an entry indicating if the multimedia segment is rendered as video with a customized audio overlay as taught by Lindstrom in order to enable local advertisers to produce inexpensive and effective full motion video commercials.

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Regarding claim 2, as disclosed in claim 1 rejections, Picco discloses the selected pieces of the local content are stored in the set top box (column 3, lines 14-30).

Regarding claim 3, Picco discloses the local content (segments) may be transmitted from a satellite system, a cable based system, or any other type (column 4, lines 51-65), which meets the limitation on receiving over a broadcast infrastructure.

Regarding claim 4, Picco discloses the database provides local content of advertisements (column 6, lines 57-61). Picco discloses the system could use a network such as the Internet to broadcast the targeted commercial (column 14, lines 58-67); a network has a server computer (program provider) that will have the database memory (computer readable medium) of local content to provide to the user.

Regarding claim 5, Picco discloses the local content (segments) may be transmitted from a satellite system, a cable based system, or any other type (column 4, lines 51-65), which meets the limitation on receiving over a telecommunications network.

Regarding claim 6, Picco discloses the system could use the Internet to broadcast the targeted commercial (column 14, lines 58-67).

Regarding claim 7, Picco discloses the local content (segment) is output to a television to be viewed by a viewer (column 12, lines 24-36).

Regarding claim 8, Picco discloses the local content (segment) are advertisements (column 12, lines 37-58).

Regarding claim 9, Picco discloses the live data streams may be digital (column 3, lines 7-10). Picco discloses the splicer determines which piece of local content to insert based on the size of the space in the programming data stream (column 10, line 58-column 11, line 13); digital

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data streams are segmented by bits, when the space for the local content is finished, the playlist will indicate for the local content to stop splicing and will switch to displaying the live data stream. The respective portions of the live digital data stream before and after the splicing also read on segments.

Regarding claims 11-12, 14-17, the limitations in claim 11-12, 14-17 has been met in claims 1-6 rejections.

Regarding claim 13, as disclosed in claim 1 rejection, Picco discloses the scheduler provides control information comprising a content profile that indicates that households in certain geographic regions should store the content (column 2, lines 49-58 and column 7, line 61-column 8, line 6), which meets the limitation on grouping one or more clients receiving a playlist based on demographics of the viewers multimedia presentation and transmitting identical playlist to one or more clients based on the grouping.

Regarding claims 18-26, the limitations in claim 18-26 has been met in claims 1-9 rejections. Picco discloses the system could use a network such as the Internet to broadcast the targeted commercial (column 14, lines 58-67); a network has a server computer (program provider) that will have the database memory (computer readable medium) of local content to provide to the user.

Regarding claims 28-33, the limitations in claims 28-33 has been met in claims 1-6 rejections. Picco discloses a system claims 1-17.

3. Claims 10 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Picco in view of Lindstrom.

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Regarding claim 10, as previously disclosed in claim 1 rejection, Picco discloses the data transmission facility assembles and transmits individualized instructions (play-list) to each set-top box and the instructions indicate what local content should be stored and **when** each piece of local content should be inserted into the live data streams (column 3, lines 1-13). Additionally, as disclosed in claim 1 rejection, Lindstrom discloses the programmed **schedule** can cause the control means can add audio signals drawn to a particular local advertiser to produce a custom spot message thereby producing a full motion video with audio (column 4, line 44-column 5, line 16).

Neither Picco nor Lindstrom discloses the time of rendering being the date. The examiner takes Official Notice that a date being a form of time is notoriously well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Picco in view of Lindstrom to have the instructions or the schedule for the time of rendering content comprise of a date for rendering content in order to provide a more specific time of rendering content.

Regarding claim 27, the limitations in claim 27 have been met in claim 10 rejection.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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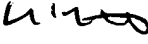
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason J. Chung whose telephone number is (703) 305-7362. The examiner can normally be reached on M-F, 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew I. Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

JJC


VICTOR R. KOSTAK
PRIMARY EXAMINER